



AF/3728 JFW

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FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$)**165.00**

Complete if Known

| | |
|----------------------|----------------|
| Application Number | 09/830,242 |
| Filing Date | 04/24/2001 |
| First Named Inventor | Soren Vindriis |
| Examiner Name | T. Arnold II |
| Art Unit | 3728 |
| Attorney Docket No. | PATRADE |

METHOD OF PAYMENT (check all that apply)

☒ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☐ Deposit Account:

Deposit Account Number
Deposit Account Name

The Director is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Credit any overpayments

☐ Charge any additional fee(s) or any underpayment of fee(s)

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FEE CALCULATION

1. BASIC FILING FEE

| Large Entity | | Small Entity | | Fee Description | Fee Paid |
|--------------|----------|--------------|----------|------------------------|----------|
| Fee Code | Fee (\$) | Fee Code | Fee (\$) | | |
| 1001 | 770 | 2001 | 385 | Utility filing fee | |
| 1002 | 340 | 2002 | 170 | Design filing fee | |
| 1003 | 530 | 2003 | 265 | Plant filing fee | |
| 1004 | 770 | 2004 | 385 | Reissue filing fee | |
| 1005 | 160 | 2005 | 80 | Provisional filing fee | |

SUBTOTAL (1) (\$)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

| | | Extra Claims | | Fee from below | | Fee Paid |
|--------------------|----------------------|--------------|----------------------|----------------|----------------------|----------------------|
| Total Claims | <input type="text"/> | -20** = | <input type="text"/> | X | <input type="text"/> | <input type="text"/> |
| Independent Claims | <input type="text"/> | -3** = | <input type="text"/> | X | <input type="text"/> | <input type="text"/> |
| Multiple Dependent | <input type="text"/> | | | | <input type="text"/> | <input type="text"/> |

| Large Entity | | Small Entity | | Fee Description |
|--------------|----------|--------------|----------|--|
| Fee Code | Fee (\$) | Fee Code | Fee (\$) | |
| 1202 | 18 | 2202 | 9 | Claims in excess of 20 |
| 1201 | 86 | 2201 | 43 | Independent claims in excess of 3 |
| 1203 | 290 | 2203 | 145 | Multiple dependent claim, if not paid |
| 1204 | 86 | 2204 | 43 | ** Reissue independent claims over original patent |
| 1205 | 18 | 2205 | 9 | ** Reissue claims in excess of 20 and over original patent |

SUBTOTAL (2) (\$)

**or number previously paid, if greater. For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Small Entity

| Fee Code | Fee (\$) | Fee Code | Fee (\$) | Fee Description | Fee Paid |
|----------|----------|----------|----------|--|----------|
| 1051 | 130 | 2051 | 65 | Surcharge - late filing fee or oath | |
| 1052 | 50 | 2052 | 25 | Surcharge - late provisional filing fee or cover sheet | |
| 1053 | 130 | 1053 | 130 | Non-English specification | |
| 1812 | 2,520 | 1812 | 2,520 | For filing a request for ex parte reexamination | |
| 1804 | 920* | 1804 | 920* | Requesting publication of SIR prior to Examiner action | |
| 1805 | 1,840* | 1805 | 1,840* | Requesting publication of SIR after Examiner action | |
| 1251 | 110 | 2251 | 55 | Extension for reply within first month | |
| 1252 | 420 | 2252 | 210 | Extension for reply within second month | |
| 1253 | 950 | 2253 | 475 | Extension for reply within third month | |
| 1254 | 1,480 | 2254 | 740 | Extension for reply within fourth month | |
| 1255 | 2,010 | 2255 | 1,005 | Extension for reply within fifth month | |
| 1401 | 330 | 2401 | 165 | Notice of Appeal | |
| 1402 | 330 | 2402 | 165 | Filing a brief in support of an appeal | 165 |
| 1403 | 290 | 2403 | 145 | Request for oral hearing | |
| 1451 | 1,510 | 1451 | 1,510 | Petition to institute a public use proceeding | |
| 1452 | 110 | 2452 | 55 | Petition to revive - unavoidable | |
| 1453 | 1,330 | 2453 | 665 | Petition to revive - unintentional | |
| 1501 | 1,330 | 2501 | 665 | Utility issue fee (or reissue) | |
| 1502 | 480 | 2502 | 240 | Design issue fee | |
| 1503 | 640 | 2503 | 320 | Plant issue fee | |
| 1460 | 130 | 1460 | 130 | Petitions to the Commissioner | |
| 1807 | 50 | 1807 | 50 | Processing fee under 37 CFR 1.17(q) | |
| 1806 | 180 | 1806 | 180 | Submission of Information Disclosure Stmt | |
| 8021 | 40 | 8021 | 40 | Recording each patent assignment per property (times number of properties) | |
| 1809 | 770 | 2809 | 385 | Filing a submission after final rejection (37 CFR 1.129(a)) | |
| 1810 | 770 | 2810 | 385 | For each additional invention to be examined (37 CFR 1.129(b)) | |
| 1801 | 770 | 2801 | 385 | Request for Continued Examination (RCE) | |
| 1802 | 900 | 1802 | 900 | Request for expedited examination of a design application | |

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$)**165.00**

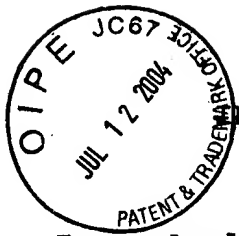
SUBMITTED BY

| | | | | | |
|-------------------|----------------------------|------------------|--------|-----------|----------------|
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| Signature | <i>Meera P. Narasimhan</i> | (Attorney/Agent) | | Date | 07/12/2004 |

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

SOREN VINDRIIS

Serial No.: 09/830,242

Art Unit: 3728

Filed: April 24, 2001

Examiner: T. Arnold III

For: AN INSOLE WITH FABRIC

APPEAL BRIEF

To the Commissioner of Patents and Trademarks

Sir:

REAL PARTY IN INTEREST

The above-identified Applicant is the real party in interest in this case.

RELATED APPEALS AND INTERFERENCES

No other related Appeals or Interferences are pending.

STATUS OF CLAIMS

Claims 1-11 were finally rejected.

A copy of the appealed claims is appended hereto in the Appendix.

STATUS OF AMENDMENTS

No amendments were filed after the final rejection.

09/830,242

SUMMARY OF THE INVENTION

The invention (Specification pages 2-6; Figure 1) relates to a sole comprising a top foil 1 and a bottom foil 2. The top-foil 1 and the bottom foil 2 are joined along the edge region 3 forming a cavity 4 between the top foil and the bottom foil. The cavity is filled with liquid 5, for example water. The cavity 4 may also be filled with a gel, and liquids other than water (specification page 3, lines 19-23).

In Figure 1, the top foil 1 as well as the bottom foil 2 are equipped with fabrics 6, 7. Fabrics 6, 7 are joined with foils 1, 2 so that the fabrics 6, 7 extend on an outer side 8, 9 of the foils 1, 2. Underneath the sole is the bottom 10 of the footwear and above the sole is a foot 11 with a sock 12 or a stocking (specification page 3, lines 23-27).

The fabrics 6, 7 are joined with the foils 1, 2, preferably with the fibres 13, 14 in the fabrics 6, 7 situated outside an outer side of the foils (specification page 3, lines 29-30).

The joining is done in a way that the fabrics 6, 7 are partly enclosed in the foils 6, 7. The fabrics 6, 7 are, thus, joined with the foils 1, 2 by heating the foils 1, 2 whereafter the fabrics 6, 7 are pressed partly into the foils 1, 2. Alternatively, however, the fabrics 6, 7 can be joined such that the fabrics are entirely enclosed in the foils 1, 2. The fabrics are, thus, joined with the foils 1, 2 by heating the foils 1, 2 whereafter the fabrics 6, 7 are pressed entirely into the foils 1, 2 (specification page 4, lines 1-6).

The foils 1, 2 are made from plastic. Joining of the foils 1, 2 along the edge region is accomplished by hot welding or high frequency welding where the top foil 1 and the bottom foil 2 are pressed together along the edge region 3 at the same time. By the welding, a bead 15 is formed extending inwards into the cavity 4. The bead 15 is formed because the material floats inwards at the location where the welding and the pressing takes place. When liquid or gel 5 is subsequently filled in between the top foil 1 and the bottom foil 2, the cavity 4 is formed (specification page 4, lines 8-14).

By the formation of the cavity 4, the top foil 1 gets stretched. The thickness t of the material along that part of the top foil 1, which extends in the near vicinity of and from the welding has a thickness which is smaller than the thickness T of the material in the remaining part of the top foil 1. Under load, there is, along that part of the top foil which is stretched, a risk for breakage as a result of creep that can occur in that part, where the strength of the top foil is decreased because of the smaller material thickness t (specification page 4, lines 16-22).

The fabrics 6, 7 may be any kind of fabric with fibres 13, 14. The fabrics 6, 7 can be made of synthetic materials as polyester or of natural materials as cotton, or a mixture of fibres of different materials. Furthermore, the fabrics 6, 7 can be woven fabrics, knitted fabrics, or non-woven fabrics. As

mentioned, the fabrics 6, 7, extend outside the outer sides 8, 9 of the foils 1, 2 (specification page 4, lines 24-28).

The fabrics 6, 7 are selected due to given mechanical and physical characteristics. Primarily, it is important that the fibres 13, 14 in the fabrics 6, 7 and the fabrics 6, 7 themselves in the plane of the fabrics 6, 7 have a tensile strength which is higher than the comparable tensile strength of the foils 1, 2 to ensure a reduction or elimination of creep (specification page 4, lines 30-33).

Secondarily, the fabrics 6, 7 are selected to make allowance for needs and wants for friction, moisture absorption and other factors in connection with comfort for the foot. Thus, the fabric 14 in the bottom foil 2 is selected secondarily to provide a high frictional coefficient between that part of the fabric that extends outside the bottom foil 2 and the bottom 10 of the foot wear. The fabric 13 in the top foil 2 on the other hand is selected secondarily to provide a low frictional coefficient between that part of the fabric 13 which extends outside the top foil 1 and the foot 11 (specification page 5, lines 2-8).

The foot 11 is normally furnished with an article of clothing as, for example, a cotton sock or a nylon. The fabric 13 and the material of which the fabric 13 is made is, therefore, selected based on the want of a low frictional coefficient in connection with conventional textile used for socks and stockings. Furthermore, the fabric 13 on the top foil 1 can be

impregnated with a fungicide to reduce the risk for epidermophytosis (specification page 5, lines 10-14).

Furthermore, it is possible to provide the foils 1, 2 with several fabrics with different mechanical and physical characteristics to selectively make allowance for primarily the strength of the fibres 13, 14 and the fabrics 6, 7 and secondarily the frictional co-efficient between the fibres, the fabrics, the bottom of the footwear, the sock and/or the foot (specification page 5, lines 28-32).

This can imply that at least two fabrics with different fibres or different weaves are used in the same foil or, respectively, in the top foil or bottom foil. In this case, one fabric completely contained in the foil can be provided causing strength and a second fabric, which, as shown, is found at the outer side 8, 9, of the foils or is only partly contained in the foils 1, 2, concerns the frictional coefficient at the bottom of the footwear, respectively the foot, eventually with sock or stocking (specification page 6, lines 1-5).

ISSUES

Whether claims 2, 3, and 7-11 are patentable under 35 U.S.C. 112, second paragraph?

Whether claims 1-11 are patentable under 35 U.S.C. 103(a) over Hutcheson (U.S. Patent 5,067,255) in view of Ogden (U.S. Patent 5,714,229) and Singh (U.S. Patent 4,137,110)?

GROUPING OF CLAIMS

The claims do not stand or fall together.

ARGUMENTS

Claims 2,3, and 7-11 are patentable under 35 U.S.C. 112, second paragraph.

The Examiner's interpretation of the features defined in claims 2, 3, 8, and 9 is in error.

The Examiner states that no patentable weight will be given to the features defined in claims 2, 3, 8, and 9, particularly the features defining the smooth surface of the bottom of the footwear. The Examiner reasons that the coefficient of friction "is a non-unitized value comparing the resistance to sliding of a surface compared to a standard surface." That statement underlines the examiner's confusion in understanding the term "between" in claims 2, 3, 8, and 9.

Claims 2, 3, 8, and 9 expressly point out that the coefficient of friction is larger as between the bottom or top foil with the fabric and the smooth surface in a bottom of the footwear versus the foil without the fabric and the same smooth surface of the footwear. Between defines the relationship "between" the foil and footwear smooth surface with and without the fabric on the foil, respectively. Thus, the Examiner's premise is wrong and the Examiner's refusal to consider all the claimed features of 2, 3, 8, and 9 is arbitrary, capricious and in error.

Moreover, this case has been examined several times before the final rejection and the terminology "between" in claims 2, 3, 8, and 9 were on record well before the final rejection. Also, claim 2 recited "the" footwear and the Examiner never raised this issue prior to the final rejection. The same holds true for claim 7 ("the" gel). However, the Examiner raises the 112, second paragraph rejection for the first time in the final office action and denies Applicant any opportunity to rebut a first action final rejection of claims 2, 3, 8, and 9.

Withdrawal of the rejection is respectfully requested.

The present claims are patentable under 35 U.S.C. 103(a).

In considering the patentability of the present invention, it is requested that the Board consider the invention as a whole, consider the scope and content of the prior art as a whole, consider the differences between the claims at issue and the prior art, and consider the level of ordinary skill in the art to which the invention pertains at the time the invention was made.

Graham v. John Deere Co., 148 USPQ 459, 467 (1966).

THE INVENTION AS A WHOLE

The invention considered as a whole is best described by the appended claims.

PRIOR ART AS A WHOLE

The prior art to which the invention pertains is typified by the references of record.

DIFFERENCES BETWEEN THE INVENTION AND THE PRIOR ART

Each of the present claims defines unique features and each is individually patentable over the prior art.

The test in reviewing rejections under 35 U.S.C. 103 in which the examiner has relied on teachings of several references, is whether references, viewed individually and collectively, would have suggested claimed invention to a person possessing ordinary skill in the art, and citing references which merely indicate that isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that combination of the claimed elements would have been obvious. Ex parte Hiyamizu, 10 USPQ2d 1393-1395 (Board of Patent Appeals and Inter., 1988); In re Kaslow, 217 USPQ 1089 (Fed. Cir. 1983); In re Deminski, 230 USPQ 313 (Fed. Cir. 1986).

Claims 1-11 are patentable under 35 U.S.C. 103(a) over Hutcheson in view of Ogden and Singh.

The Examiner's comments about refusal to give patentable weight "for reinforcingcreep" as being "intended use" is in error. The Examiner raises this issue for the first time in the final office action thereby denying Applicant due process to adequately rebut the issue raised in a first action final

rejection. Thus, the Examiner's action is arbitrary, capricious and erroneous.

Besides, the language pointed out by the Examiner indicates that the Examiner fails to understand that "reinforcing ... the foil against creep" is not intended use but rather the functional result of the unique property of the fabric penetrating into the foil. The Examiner may have misunderstood "creep" as a some kind of use rather than as a problem that exists in conventional footwear. Thus, because the Examiner's refusal to consider important claimed features is based on erroneous understanding, withdrawal of the premise and consideration of all the claimed elements is respectfully requested.

Each of the present claims distinguishes the invention from the prior art. None of the references considers, approaches or solves the prior art problem of creep.

Hutcheson covers but does not press a fabric into a plastic foil.

Ogden coats a fabric with a liquid barrier.

Singh impregnates fabric with a latex bonder in a completely different art.

Claim 1 describes an insole for footwear comprising a plastic top foil and a plastic bottom foil having edge regions and one or more cavities formed between the top foil and the bottom foil and filled with a liquid or a gel. The top foil and the bottom foil are impermeable with respect to the liquid or gel and are joined together at least along the edge regions. At

least one of said foils is equipped with a fabric extending over an outer surface of said at least one of said foils. The fabric extends parallel with said at least one of said foils and the fabric is joined with said at least one of said foils by at least partially pressing the fabric into said at least one of said foils such that the fabric penetrates below an exterior surface of said at least one of said foils for reinforcing the mechanical strength of the foil against creep. The references do not describe, teach nor suggest all the claimed features of claim 1.

Claim 7 describes an insole for footwear comprising a plastic top foil and a plastic bottom foil, one or more cavities formed between the top foil and the bottom foil and filled with a liquid. The top foil and the bottom foil are impermeable with respect to the liquid or gel and are joined together at least along edge regions of the top foil and the bottom foil. The top foil and the bottom foil are equipped with fabrics extending on the foils between the edge regions where the top foil is joined with the bottom foil. The fabrics extend parallel with the foils and partially extend outside of the outer sides of the foils. The fabrics are joined with the foils by mechanical joining and partial enclosure in the foils for reinforcing mechanical strength of the foils against creep. In the mechanical joining the foils initially are heated, the fabrics subsequently are pressed partly into the foils, and the foils finally are cooled, whereby at least parts of the fabrics which are pressed into the

foils are enclosed in the foils. The references do not describe, teach nor suggest all the claimed features of claim 7.

No motivation arises in the references which would have suggested the present new solution to the problem of pressure induced creep.

Singh is for air permeable insoles and would have lead away from the present invention, and would have led away from a combination with Hutcheson. The first words in Singh are "Air permeable". The latex binder only serves to hold a mat of fibers together. Seeing that, one skilled in the art would have been immediately taught away from combining Singh with Hutcheson.

Ogden proposes an apertured top layer. Nothing in Ogden or Hutcheson would have suggested their combination.

Ogden's apertured top layer is intended to "limit movement of the foot and sock with respect to the insole" (column 1, line 3). Ogden uses a molded polyurethane as the cushioning layer (column 6, line 45+). A two-sided non woven layer is connected to the aperture top layer. One side is wicking fibers, the second side is non-absorbent fibers (column 6, line 25+). The barrier layer stops flow of liquid polyurethane into the two-sided layer during molding (column 6, line 40).

Ogden, from an unrelated art, would have lead away from the present invention and from a combination with Hutcheson and/or singh. Ogden is non-analogous art and is not available as a reference against the present claims. See In re Oetiker, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992): "In order to rely on a

reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." citing In re Deminski, 230 USPQ 313, 315 (Fed. Cir. 1986). "The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness." In re Oetiker, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992).

Uniquely the invention solves two problems, first creep and second friction. No reference solves the first problem or the second problem.

The Examiner's observation on page 7, that **"Regardless of ... the problems [Applicant's invention] proposes to solve ..."** the rejection is maintained; and further **"Again, the problem Applicant intends to resolve is not germane to the argument ..."** shows that the Examiner may not be aware of the Federal Circuit's dictates about the patentability of inventions that solve long standing problems. There is precedence that, "where the invention for which a patent is sought solves a problem which persisted in the art, we must look to the problem as well as to its solution if we are to properly appraise what was done and to evaluate it against what would be obvious to one having the ordinary skills of the art." In re Rothermal, 125 USPQ 328, 332 (CCPA, 1960).

Friction on the foot covering is bad. The invention solves that problem by partially pressing the creep-preventing fabric into the outer surface of the top foil and producing a surface with reduced friction.

Sliding of the bottom plastic foil in a shoe or boot (footwear) is bad. The invention solves that problem by pressing the creep-preventing fabric into the outer surface of the bottom foil and creating an outer surface with an increased friction on the lower foil.

Any one of those solutions would have been non-obvious and patentable.

Claim 6 teaches the production of a liquid filled insole with increased strength. A liquid filled insole with two plastic layers is formed, a layer is heated, and a fabric is pressed into the molten surface of the layer. This increases the mechanical strength of the layer for reducing or eliminating creep.

Particularly, claim 6 defines a method for production of an insole for footwear comprising providing a plastic top foil and a plastic bottom foil, the top foil and the bottom foil being impermeable to liquid, joining the top foil and the bottom foil together at least along edge regions, forming one or more cavities between the top foil and the bottom foil, filling the cavities with a liquid or a gel, equipping at least one of said foils with a fabric for reinforcing the mechanical strength of said at least one of said foils against creep, the fabric extending over said at least one of said foils, initially heating

said at least one of said foils, pressing the fabric partly or totally into said at least one of said foils whereby that part of the fabric which is pressed into the foil is partly or totally in said at least one of said foils such that the fabric penetrates below an exterior surface of said at least one of said foils, and cooling the foil.

The actual process is described in the specification. The fabric with reinforcing fibers is placed on an outer surface of a plastic layer. By applying pressure and heat, the fabric and fibers are pressed into the plastic layer in order to be confined in the layer when the layer is cold. The enclosure of the fabric stabilizes and strengthens the plastic layer such that creep is reduced or does not occur, in contrast to the insole by Hutcheson.

Concerning claim 6, Hutcheson does not teach heating the foil, pressing the fabric into the foil, and cooling the foil. This has also been acknowledged by the examiner in the office action.

The question is whether it would have been obvious at the time the invention was made for one of ordinary skill to have done what is described in claim 6. Hutcheson only teaches a gluing of a fabric onto the surface of the plastic insole. The problem solved by the invention is providing an increased tensile strength of the insole in order to reduce or prevent creep of the plastic foils during load. Hutcheson does not mention this

problem and would therefore not give any indication for how to solve this problem.

In order to understand the problem more deeply, as described in the specification:

Fluid filled soles, like Hutcheson's suffer from the fact that the plastic layers under load are subject to creep, which makes the layers longer. It has to be realized that the pressure on the insole is rather high, especially under running conditions. The result is that the plastic layers get longer and the sole does not keep its shape and becomes less shock absorbing. Usually, insoles of this kind last very short times when used.

On the road from the Hutcheson insole to the invention, the man skilled in the art as a first step would have had to realize that an insole is subject to creep due to structural changes caused by load. This subject has not been treated by Hutcheson.

As a second step, the man skilled in the art would have had to realize, that the problem may be solved by providing a stronger liquid filled insole. This step would not have been obvious, as a man skilled in the art has every other solution at his hand, for example providing insoles with polymer foam instead.

As mentioned, Hutcheson does not provide any hint for how to improve insoles concerning stability. The question is, where would a man skilled in the art get the necessary information? There are many disclosures of insoles and liquid filled insoles

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and many different directions may be followed. Thus, as a third step, the man skilled in the art would have had to realize that an improvement would have been gained from the disclosure by Ogden.

In deciding that a novel combination would have been obvious, there must be supporting teaching in the prior art. There is no suggestion or motivation in the prior art to combine the elements as done by the present invention and hence the claims cannot be rendered obvious. In re Newell, 13 USPQ2d 1248, 1250 (CAFC, 1989).

What would the man skilled in the art have learned from Ogden? Ogden teaches that a non-woven fabric 22 may be heat bonded or glued to a (top) layer (col. 12, lines 40-41) in order to achieve a laminate. This heat bonding is achieved as explained in col. 11 line 62 to col. 12, line 4. Thus, the surface of the top layer is "softened to some extent" (col. 11, line 65) and bonds to the fibers. But Ogden's fibers are not pressed into the layer for enclosure. At this stage, the man skilled in the art as a fourth step would have had to use the teaching from Ogden in order to strengthen the layers in the liquid filled sole. However, he would not have achieved an insole as described by the method claim 6, because the fibers are not enclosed in the foil.

Alternatively, the man skilled in the art could have applied Ogden in an alternative way. He could have covered the non-woven fabric with a liquid polymer as explained in col. 13, line 4-7.

The hardened liquid polymer would at least partly enclose the fabric. However, the liquid filled insole would not enclose the fabric, because the liquid filled insole cannot be applied to the fabric in a liquid state, because the outer layers of the liquid filled insole has to confine the liquid.

The man skilled in the art would have ended up with a liquid filled insole as Hutcheson's, and a polymer enclosed fabric, where the liquid filled insole and the polymer enclosed fabric has to be bonded together afterwards. This could be done by heat bonding, where Ogden teaches, that the top layer is "softened to some extend" (col. 11, line 65) and bonds to the fibers. Also in Ogden the fibers are not pressed into the layer for enclosure.

That [the prior art] might incorporate elements which could be used in appellants' system does not render appellants' claims obvious when there is no suggestion of using these elements in substantially the same manner as appellants use them. In re Donovan, 184 USPQ 414, 421 (CCPA, 1975).

Nothing in the references teaches, suggests or motivates one of ordinary skill in the art to combine the references in the manner proposed by the Examiner.

Therefore, even if the man skilled in the art would have performed the steps above, including realizing the problem, finding the right source of information and applying this information, he would not have achieved the method according to claim 6 or an insole according to claims 1 and 7 by any combination of the teaching of Hutcheson and Ogden.

Therefore, the method, according to claim 6, and the insole, according to claims 1 and 7, would not have been obvious.

See In re Meng, 181 USPQ 94, 97 (CCPA 1974), wherein the Court held:

"Of course the invention seems simple, after the fact. But simplicity, particularly in an old and crowded art, may argue for rather than against patentability. In re Sporck, 133 USPQ 360 (CCPA 1962). Progress in the crowded arts, usually made in small increments, is as important as it is in arts at the pioneer stage. In re Hummer, 113 USPQ 66 (CCPA 1957). The Constitution envisages and seeks progress in the 'useful arts,' not just those more esoteric or scientific."

Regarding claims 2, 3, 8, and 9, the Examiner acknowledges that the references do not teach the claimed features. Also the Examiner refuses to give patentable weight to those features and yet maintains that those features are obvious. Thus, Applicant is unable to adequately address those claim rejections.

Claim 2 adds to claim 1 that the bottom foil is equipped with the fabric, and a frictional coefficient between the bottom foil equipped with the fabric and a substantially smooth surface in a bottom of the footwear is larger than a frictional coefficient between the bottom foil without the fabric and the substantially smooth surface in the bottom of the footwear. The Examiner acknowledges that the references do not teach those features and yet maintains that those features are obvious and will not be given patentable weight. The mutually contradictory stance is impossible to rebut because applicant has not guidance as to which of the Examiner's stance Applicant must pick and choose to adequately rebut the obviousness rejections.

Claim 3 adds to claim 1 that the top foil is equipped with the fabric and the frictional coefficient between the top foil equipped and impregnated with fabric and a foot covering textile such as cotton, polyester or nylon is lower than a frictional coefficient for the top foil without the fabric and the foot covering textile. The Examiner acknowledges that the references do not teach those features and yet maintains that those features are obvious and will not be given patentable weight. The mutually contradictory stance is impossible to rebut because applicant has not guidance as to which of the Examiner's stance Applicant must pick and choose to adequately rebut the obviousness rejections.

Claim 8 adds to claim 7, that the fabrics differ and the bottom foil is equipped with a fabric which with respect to a substantially smooth surface in the bottom of the footwear has a frictional coefficient which is larger than a frictional coefficient of the bottom foil with respect to the substantially smooth surface in the bottom of the footwear. The Examiner acknowledges that the references do not teach those features and yet maintains that those features are obvious and will not be given patentable weight. The mutually contradictory stance is impossible to rebut because applicant has not guidance as to which of the Examiner's stance Applicant must pick and choose to adequately rebut the obviousness rejections.

Claim 9 adds to claim 7 that the top foil is equipped with a fabric which with respect to a foot covering textile such as

cotton, polyester or nylon has a frictional coefficient which is lower than a frictional coefficient of the top foil with respect to the foot covering textile. The Examiner acknowledges that the references do not teach those features and yet maintains that those features are obvious and will not be given patentable weight. The mutually contradictory stance is impossible to rebut because applicant has not guidance as to which of the Examiner's stance Applicant must pick and choose to adequately rebut the obviousness rejections.

Claim 4 adds to claim 1, and claim 10 adds to claim 7 that the fabric is made of fibers and is woven such that the fabric in every direction in the plane of the fabric has a tensile strength that is higher than a tensile strength of said at least one of the foils in any direction planar with said at least one of the foils. Nothing in the combined teachings of Hutcheson, Ogden and Singh describe, teach or suggest the tensile strength in every direction if fabric which is higher than the tensile strength of the foils.

Claim 5 adds to claim 1 and claim 11 adds to claim 7 that the fabric is joined with the top foil and is impregnated with a fungicide which is not taught nor suggested by the references.

In reality, the insoles by the inventor are by far superior than any other kind of liquid filled insoles on the market due to the fact that the lifetime of these insoles is far longer than for any other product of this kind. The result is that the insole according to claims 1 and 7 produced according to claim 6

is becoming a commercial success. Thus, the invention fulfills a long felt need by potential users. This is an indication for the non-obviousness of the invention, because nobody has hitherto proposed an insole with the properties defined in the present claims.

In In re Fine, 5 USPQ2d 1596, 1599 (Fed. Cir 1988), the Court observed:

"Because neither [reference], alone or in combination, suggests the claimed invention, the Board erred in affirming the Examiner's conclusion that it would have been obvious to substitute the [secondary reference features] in the [primary system]. The [references] disclose, at most, that one skilled in the art might find it obvious to try the claimed invention. But whether a particular combination might be 'obvious to try' is not a legitimate test of patentability. In re Geiger, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987); In re Goodwin, 198 USPQ 1, 3 (CCPA 1978).

Thus, there is no prima facie case of obviousness with respect to any of the claims.

Nothing in the references, either singly or in combination, teaches or suggests the claimed features. Therefore, the references cannot anticipate nor render obvious the present invention as claimed.

LEVEL OF ORDINARY SKILL IN THE ART

A person having ordinary skill in the art is an artisan being taught the reference teachings.

SUMMARY

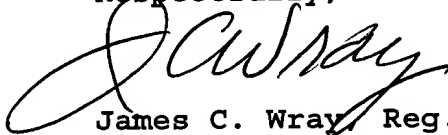
Each of the present claims is patentable under 35 U.S.C. 112, second paragraph.

When considering the present invention as a whole and the prior art to which the invention pertains as a whole, when considering the differences between the present invention and the prior art, and when considering the level of ordinary skill in the art to which the invention pertains, it is clear that the invention would not have been obvious under 35 U.S.C. 103(a) to a person having ordinary skill in the art at the time the invention was made.

CONCLUSION

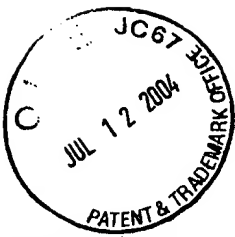
Reversal of the Examiner and allowance of all the claims are respectfully requested.

Respectfully,

A handwritten signature in black ink, appearing to read 'J C Wray', is written over the typed name.

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APPENDIX

Appealed Claims

1. An insole for footwear comprising:
a plastic top foil and a plastic bottom foil having edge regions;
and one or more cavities formed between the top foil and the bottom foil and filled with a liquid or a gel;
wherein the top foil and the bottom foil are impermeable with respect to the liquid or gel and are joined together at least along the edge regions;
wherein at least one of said foils is equipped with a fabric extending over an outer surface of said at least one of said foils;
wherein the fabric extends parallel with said at least one of said foils; and
wherein the fabric is joined with said at least one of said foils by at least partially pressing the fabric into said at least one of said foils such that the fabric penetrates below an exterior surface of said at least one of said foils for reinforcing the mechanical strength of the foil against creep.
2. An insole according to claim 1, wherein the bottom foil is equipped with the fabric, and a frictional coefficient between the bottom foil equipped with the fabric and a substantially smooth surface in a bottom of the footwear is larger than a frictional coefficient between the bottom foil without the fabric

and the substantially smooth surface in the bottom of the footwear.

3. An insole according to claim 1, wherein the top foil is equipped with the fabric and the frictional coefficient between the top foil equipped and impregnated with fabric and a foot covering textile such as cotton, polyester or nylon is lower than a frictional coefficient for the top foil without the fabric and the foot covering textile.

4. An insole according to claim 1, wherein the fabric is made of fibers and is woven such that the fabric in every direction in the plane of the fabric has a tensile strength that is higher than a tensile strength of said at least one of the foils in any direction planar with said at least one of the foils.

5. An insole according to claim 1, wherein the fabric is joined with the top foil and is impregnated with a fungicide.

6. A method for production of an insole for footwear comprising:

providing a plastic top foil and a plastic bottom foil, the top foil and the bottom foil being impermeable to liquid;

joining the top foil and the bottom foil together at least along edge regions;

forming one or more cavities between the top foil and the bottom foil;

filling the cavities with a liquid or a gel; and

equipping at least one of said foils with a fabric for reinforcing the mechanical strength of said at least one of said foils against creep, the fabric extending over said at least one of said foils;

initially heating said at least one of said foils;

pressing the fabric partly or totally into said at least one of said foils whereby that part of the fabric which is pressed into the foil is partly or totally in said at least one of said foils such that the fabric penetrates below an exterior surface of said at least one of said foils; and

cooling the foil.

7. An insole for footwear comprising a plastic top foil and a plastic bottom foil, one or more cavities formed between the top foil and the bottom foil and filled with a liquid, wherein the top foil and the bottom foil are impermeable with respect to the liquid or gel and are joined together at least along edge regions of the top foil and the bottom foil, wherein the top foil and the bottom foil are equipped with fabrics extending on the foils between the edge regions where the top foil is joined with the bottom foil, wherein the fabrics extend parallel with the foils, and partially extend outside of the outer sides of the foils, wherein the fabrics are joined with the foils by mechanical joining and partial enclosure in the foils for reinforcing mechanical strength of the foils against creep, wherein in the mechanical joining the foils initially are heated, the fabrics subsequently are pressed partly into the foils, and

the foils finally are cooled, whereby at least parts of the fabrics which are pressed into the foils are enclosed in the foils.

8. An insole according to claim 7, wherein the fabrics differ and the bottom foil is equipped with a fabric which with respect to a substantially smooth surface in the bottom of the footwear has a frictional coefficient which is larger than a frictional coefficient of the bottom foil with respect to the substantially smooth surface in the bottom of the footwear.

9. An insole according to claim 7, wherein the top foil is equipped with a fabric which with respect to a foot covering textile such as cotton, polyester or nylon has a frictional coefficient which is lower than a frictional coefficient of the top foil with respect to the foot covering textile.

10. An insole according to claim 7, wherein the fabrics are made of fibers and are woven such that the fabrics in every direction in the plane of the fabrics have tensile strengths higher than tensile strengths of one of the foils in any direction planar with the foils.

11. An insole according to claim 7, wherein a fabric which is joined with the top foil is impregnated with a fungicide.